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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,372	03/12/2001	Masami Murao	2796/IG216-US1	8850
7278	7590	04/19/2007		
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			EXAMINER REESE, DAVID C	
			ART UNIT	PAPER NUMBER
			3677	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/813,372	Applicant(s) MURAO ET AL.	
	Examiner David C. Reese	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

- Claims 1-14 are withdrawn (see below).
- Claims 1-18 are pending.

Election/Restrictions

[1] Claims 1-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. In applicant's response, it was stated "Claims 15 and newly added claims 16-18 are readable thereon". Applicant's election with traverse, however, of Claims 1-18 in the reply filed on 2/23/2007 is acknowledged. The traversal is on the ground(s) that the examiner's position that there are different species therein is erroneous, as all the constructions include similar features such as an outer casing and resilient member. The examiner disagrees. Though the function may or may not be similar, the structure and/or materials are not (as apparent from the submitted diagrams and spec) and consequently, the examiner maintains the original species restriction in the instant case. Further, only claims regarding figure 10 will be examined, as that shown in figure 11a and 11b also encompass a different species than that shown in Fig. 10. Lastly, it is pertinent that the applicant supply the correct identifiers (withdrawn) for claims 1-14 in the response to this office action.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

[2] Claim 17 objected to because of the following informalities: "the ends parts" should be "the end parts".

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[3] Claim 19 is objected to because of the following informalities: it should be labeled as claim 18. Further, claim 19 appears to be a duplicate of claim 17.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

[4] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[5] Claims 15-18 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Borofsky et al., US-4,321,804, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

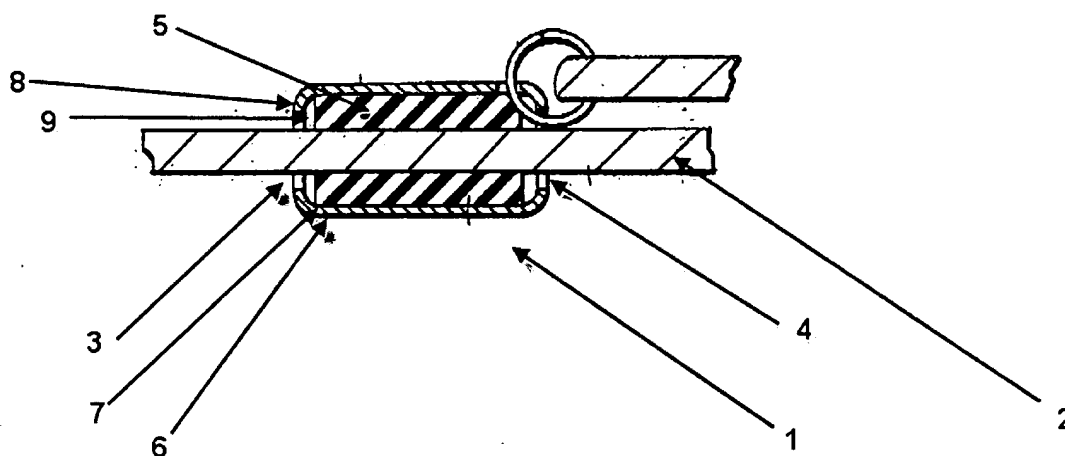
The shape and appearance of Borofsky et al. is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 15, Borofsky et al. discloses of a retainer (see figure below) (1) for adjusting a length of an ornament chain (2), in which the ornament chain (2) is slidably insertable in said retainer (1), and can be locked at a desired pull-out position (see col. 2, lines 23-35, as well as part (e) of claim 1), said retainer (1) comprising:

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a hollow casing (6) including an ingress port (3) and an egress port (4) separated from one another and adapted to allow the ornament chain (2) to pass therethrough; and

a resilient member (5) including a resilient tube having end parts and a through hole communicable with the ingress port (3) of said casing (6) for receiving the ornament chain (2) therethrough, the end parts of said resilient member (5) abut against an inner wall of said casing proximate the respective ports (at 7), an inner wall (8) of said casing (6) being separated from said tube (5) so as to define a gap (9) therebetween.



As for claim 16, Borofsky et al. discloses a retainer (see figure above) (1) for adjusting a length of an ornament chain (2), in which the ornament chain (2) is slidably insertable in said retainer (1) and can be locked at a desired pull-out position (see col. 2, lines 23-35, as well as part (e) of claim 1), said retainer (1) comprising:

a hollow casing (6) including an ingress port (3) and an egress port (4) separated from one another and adapted to allow the ornament chain (2) to pass therethrough; and

a resilient member (5) disposed in said casing (6) so as to be prevented from coming out, and adapted to be fitted onto the ornament chain (2), said resilient member (5) having a substantially cylindrical body with end parts, and said resilient member (5) having a diameter sufficiently small [to produce an urging force in a direction toward an outer periphery of the ornament chain when fitted in the resilient member];

when the ornament chain (2) protruding from said retainer (6) [is pulled, said resilient member (5) abuts against an inner wall of the casing (1) so as to be restrained], [and upon application of additional force, the ornament chain (2) is pulled out from said resilient member (1), overcoming the urging force of said resilient member (1) so as to adjust the length of the ornament chain (2)].

The above statements in brackets are examples of intended use, statements that fail to further limit the structure of the claimed invention. Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*.

Re: Claim 17, wherein end parts of said casing (1) are formed so that the diameter thereof decreases toward the respective ports (3, 4), the end parts of said resilient member (5) abut against an inner wall (at 7) of said casing (1) proximate the respective ports (3,4).

Re: Claim 18, wherein the end parts of said casing (1) are formed so that the diameter thereof decreases toward the respective ports (3,4), said resilient member (5) abuts against an inner wall (at 7) of said casing (1) proximate the respective ports (3,4).

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Conclusion

[6] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to this particular type of jewelry item; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: please see submitted notice of reference cited.

[7] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

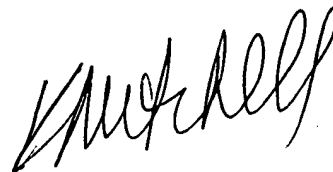
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCR



4/10/07

David Reese
Assistant Examiner
Art Unit 3677



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